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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,307	09/26/2005	James Alexander Sharpe	920602-97752	6671
23644 7590 08/20/2008 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786				
EXAMINER				
LAMB, BRENDA A				
ART UNIT		PAPER NUMBER		
1792				
NOTIFICATION DATE		DELIVERY MODE		
08/20/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-ch@btlaw.com

**Office Action Summary****Application No.**

10/518,307

**Applicant(s)**

SHARPE, JAMES ALEXANDER

**Examiner**

Brenda A. Lamb

**Art Unit**

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kling 2,583,379.

Kling teaches an apparatus for treating tissue specimens by immersion in a liquid as shown in Figure 1, the apparatus comprising a first structure providing a chamber 54 for holding the liquid, and a second structure including holding means for releasably holding the specimens, the first and second structures being relatively moveable in a direction having a vertical component between a first position in which the holding means are relatively close to the chamber and in which the second structure closes the top of the chamber to enable the specimens to be immersed in the liquid whilst the latter is protected from the environment, and a second position in which the holding means are relatively distant from the chamber to enable the specimens to be loaded onto or unloaded from the holding means. Kling shows that the chamber is circular or annular in cross-section. Kling shows the holding means in Figure 2 hold the specimens so that the latter depend from the holding means at angularly spaced positions around a circle.

Kling teaches the second structure is a lid which acts to close the chamber in the first position and the underside of it carries the holding means. With respect to claim 2, the Kling first structure is stationary and the second structure is shiftable vertically with respect to the first structure. With respect to claim 7, Kling teaches that the second structure is rotatably moveable around a central vertical axis, enabling the substrate to be loaded into and unloaded from the second structure at chosen positions alongside the apparatus by hand if desired. With respect to claim 8,

Claims 1-2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Mans 3,062,225.

Mans teaches an apparatus for treating tissue specimens by immersion in a liquid as shown in Figure 1, the apparatus comprising a first structure providing a chamber 6 for holding the liquid, and a second structure including holding means for releasably holding the specimens, the first and second structures being relatively moveable in a direction having a vertical component between a first position in which the holding means are relatively close to the chamber and in which the second structure at least partially closes the top of the chamber to enable the specimens to be immersed in the liquid whilst the latter is at least partially protected from the environment, and a second position in which the holding means are relatively distant from the chamber to enable the specimens to be loaded onto or unloaded from the holding means. Mans shows that the chamber is circular or annular in cross-section. Mans shows the holding means in Figure 1 hold the specimens so that the latter depend from the holding means at angularly spaced positions around a circle. Mans teaches the second structure is a

lid which acts to at partially close the chamber in the first position and the underside of it carries the holding means. With respect to claim 2, the Mans first structure is stationary and the second structure is shiftable vertically with respect to the first structure. With respect to claim 7, Mans teaches that the second structure is rotatably moveable around a central vertical axis, enabling the substrate to be loaded into and unloaded from the second structure at chosen positions alongside the apparatus by hand if desired.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kling 2,583,379 in view Chappa et al 6,562,136.

Kling is applied for the reasons note above but fails to teach the holding means includes magnets to enable the specimens along with its metal mount to be detachably retained on the second structure. However, it would have been obvious to modify the Kling apparatus by providing a holding means which includes magnets to secure the specimens along with its mount or supporting member to be detachably retained on the second structure since Chappa et al teaches the use of magnets to detachably retain a mounting member for the substrate from the second structure which includes holding means for the substrate (see Chappa et al column 4 lines 35-53).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mans 3,062,225 in view Chappa et al 6,562,136.

Mans is applied for the reasons note above but fails to teach the holding means includes magnets to enable the specimens along with its metal mount to be detachably retained on the second structure. However, it would have been obvious to modify the

Mans apparatus by providing a holding means which includes magnets to secure the specimens along with its mount or supporting member to be detachably retained on the second structure since Chappa et al teaches the use of magnets to detachably retain a mounting member for the substrate from the second structure which includes holding means for the substrate (see Chappa et al column 4 lines 35-53).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mans 3,062,225 in view of Polster 6,355,104.

Mans is applied for the reasons note above but fails to teach the apparatus has the facility to change the liquid when in the first position. However, it would have been obvious to modify the Mans apparatus by providing the chamber means with a drain and refilling device associated with the bath such as shown by Polster to facilitate changing of the liquid within the tank by exhausting spent treatment liquid.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kling 2,583,379 in view of Polster 6,355,104.

Kling is applied for the reasons note above but fails to teach the the apparatus has the facility to change the liquid when in the first position. However, it would have been obvious to modify the Kling apparatus by providing the chamber means with a drain and refilling device associated with the bath such as shown by Polster to facilitate changing of the liquid within the tank by exhausting spent treatment liquid.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation in claim 8 that the apparatus has the facility or capability to change the liquid in the first position is confusing since it is unclear whether one is changing the liquid inside the chamber by facilitating a chemical reaction therein or whether one is changing by draining the liquid in the chamber and providing another liquid therein.

Applicant's arguments filed 4/30/2008 have been fully considered but they are not persuasive. Applicant's arguments that his invention defines over Kling in that it has a single trough and a single lid enables all specimens to be treated identically is found to be non-persuasive since it is not commensurate in scope with claim language with the claim open with the term "comprising" to more than one lid and more than trough or chamber with the term "annular" trough broadly reading on the cross-sectional shape of the trough.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda A. Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday-Tuesday and Thursday. The examiner can also be reached on alternate Wednesdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton, can be reached on (571) 272-1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brenda A Lamb  
Primary Examiner  
Art Unit 1792

/Brenda A Lamb/

Primary Examiner, Art Unit 1792